

REMARKS

Claims 1, 3-5, 7-11, 13-15 and 17-21 are pending in this application. Claims 1 and 11 are independent claims. By this Amendment, claims 1 and 11 are amended only to address the rejection under 35 U.S.C. §112. Thus, no new matter is added that would require further consideration and/or search.

Claim Rejections under 35 U.S.C. §112

Claims 1 and 11 are rejected under 35 USC §112, second paragraph, for allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. The rejection is respectfully traversed.

Claims 1 and 11 are amended in response to the rejection. Support for the amendments may be found at least at page 3, lines 11-15 and page 6, lines 25-35.

Claim Rejections under 35 U.S.C. §103

Claims 1 and 11 are rejected under 35 USC §103(a) as being unpatentable over U.S. Patent 5,896,021 to Kumar ("Kumar") in view of U.S. Patent 4,596,911 to Guery et al. ("Guery"). The rejection is respectfully traversed.

In rejecting the claims, it is alleged that the claim element of "a switch within the protective device operatively connected to the first protective element, the switch configured to turn off the electronic switching device" is inherent "since the concept of the circuit breaking is based on interruption of the power supply when some failure occurs."

Although the Examiner alleges inherency, it is clearly not inherent to have a switch operatively connected to a first protective element to turn off an electronic

switching device as demonstrated by the lack of such a device and/or configuration in Kumar. Applicants respectfully remind the Examiner that “To establish inherency, the extrinsic evidence ‘must make clear that the missing descriptive matter is **necessarily present** in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.” *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999).

Moreover, Guery specifically states that “standardization prohibits the use of switches as isolating members.” Therefore, it is not inherent that “a switch within the protective device operatively connected to the first protective element, the switch configured to turn off the electronic switching device.”

There is also no motivation to modify Kumar according to the teachings of Guery as Guery teaches away from the use of “a switch within the protective device operatively connected to the first protective element, the switch configured to turn off the electronic switching device” as Guery recognizes that “standardization prohibits the use of switches as isolating members” and that the addition of an isolating switch “increases the complexity of the installation and increases its costs.”

Because the claimed structure is not inherent and because there is no suggestion or motivation to combine the references as proposed due to the teaching away of Guery, the combination of references fails to disclose or suggest the claim features. As such, withdrawal of the rejection s requested.

Claims 7 and 17 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Kumar in view of Guery and current design practice. The rejection is respectfully traversed.

Claims 7 and 17 are allowable for their dependency on their respective base claim, as well as for the additional features recited therein. As such, withdrawal of the rejection is requested.

Claims 5, 10, 15 and 20 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Kumar in view of Guery and U.S. Patent 4,691,197 to Damiano et al. ("Damiano"). The rejection is respectfully traversed.

Claims 5, 10, 15 and 20 are allowable for their dependency on their respective base claim, as well as for the additional features recited therein. As such, withdrawal of the rejection is requested.

Claims 3, 4, 13, and 14 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Kumar in view of Guery and U.S. Patent 2,324,852 to Frank ("Frank"). The rejection is respectfully traversed.

Claims 3, 4, 13, and 14 are allowable for their dependency on their respective base claim, as well as for the additional features recited therein. As such, withdrawal of the rejection is requested.

Claims 8, 9, 18, 19 and 21 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Kumar in view of Guery, U.S. Patent 6,315,617 to Al-Sabah ("Al-Sabah") and Frank. The rejection is respectfully traversed.

Claims 8, 9, 18, 19 and 21 are allowable for their dependency on their respective base claim, as well as for the additional features recited therein. For example, it is alleged that Al-Sabah discloses the switching device, wherein the protective device and the switching device include widths of the same dimensions as in claims 8 and 18.

Specifically, it is alleged that contacting surface of the power converter 56 in the power detection module 42 has the same width as contacting surfaces of the circuit breaker 48 in the main power distribution module 22. Applicants respectfully disagree with the interpretation of the reference. First, Applicants respectfully remind the Examiner that when the reference does not disclose that the drawings are to scale and is silent as to dimensions, proportions in drawings are not evidence of actual proportions (MPEP §2125). Thus, the Examiner cannot rely on the figures of Al-Sabah as disclosing the claimed feature. Second, the box representing the power converter is not the same width as the box representing the circuit breaker 48.

For at least these reasons, the combination of references fails to disclose or suggest the features of claims 8 and 18. Accordingly, withdrawal of the rejection is requested.

CONCLUSION

In view of the above remarks and amendments, Applicants respectfully submit that each of the rejections has been addressed and overcome, placing the present application in condition for allowance. A notice to that effect is respectfully requested. If the Examiner believes that personal communication will expedite prosecution of this application, the Examiner is invited to contact the undersigned.

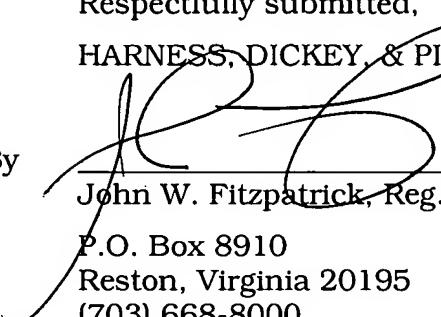
Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact John W. Fitzpatrick at the telephone number below.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 08-0750 for any additional fees required under 37 C.F.R. § 1.16 or under 37 C.F.R. § 1.17; particularly, extension of time fees.

Respectfully submitted,

HARNESS, DICKEY, & PIERCE, P.L.C.

By


John W. Fitzpatrick, Reg. No. 41,018

P.O. Box 8910
Reston, Virginia 20195
(703) 668-8000

DJD/JWF:eaf